

Application No.: 09/963,551

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REMARKS

Claims 2 and 8 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by Anderson '137 ("Anderson"). This rejection is respectfully traversed for the following reasons.

The Examiner has maintained the pending rejection based on the assertion that the "claim language does not require that the exact same frame is presented by the display and transferred." In this regard, the Examiner asserts that a "series of images includes each and every image comprising said series of images" so that in an example where there are 10 frames being transferred, "the first frame ... being displayed while the tenth frame is being transferred" is sufficient to read on claims 2 and 8. In order to clarify the distinction between the present invention and cited prior art, claim 2 now recites in pertinent part, "image data ... includes *an image* which is transferred from the image memory to the storage medium while *the image* is presented by the display" (emphasis added). Claim 8 similarly recites in method format, "storing *an image* ... on a storage medium while *the image* is presented by a display ..." (emphasis added). Accordingly, even assuming *arguendo* the Examiner's broad interpretation is proper, none of the alleged images in Anderson are disclosed as being transferred/stored while being presented by a display.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Anderson does not anticipate claims 2 and 8, nor any claim dependent thereon. The Examiner is directed to MPEP § 2143.03 under the

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section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 3 because the proposed combination fails the "all the claim limitations" standard required under § 103. It is noted that Kuchta, relied on by the Examiner in the § 103 rejection against dependent claim 3, does not obviate the aforementioned deficiencies of Anderson.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If

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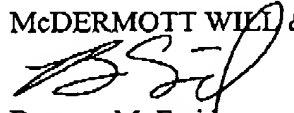
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there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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